

## REMARKS

### I. Status of Claims

Claims 1-7 and 15-16 are pending in the application. Claims 1, 5 and 15 are the elected independent claims and are currently amended. Support for the additional language of these claims can at least be found in paragraph [0038]<sup>1</sup> of the Applicant's specification as published. Without waiving any argument, and to advance prosecution, claims 8-14 and 17-18 are currently canceled without prejudice to and/or disclaimer of the subject matter therein. The Applicant reserves the right to file one or more divisional applications pursuant to the provisions of 35 USC § 121.

Claims 1-3, 5-7, 15 and 16 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Abe (USP 6,356,817) ("Abe") in view of Kuang et al. (USP 6,590,299).

Claim 4 stands rejected under 35 USC 103(a) as allegedly being unpatentable over Abe in view of Kuang and further in view of Tadao et al. (JP 2000-087785) ("Tadao").

The Applicant respectfully requests reconsideration of these rejections in view of the foregoing amendments and the following remarks.

### II. Remarks Regarding Rejections

Claims 1, 5 and 15, the only independent claims examined on the merits, stand rejected under 35 USC 103(a) as allegedly being unpatentable over Abe in view of Kuang.

It is respectfully submitted that claims 1, 5, and 15 are patentable over the cited references at least because they recite, *inter alia*, "...wherein the predetermined restricting condition is fulfilled **when a temperature of said motor** is not less than an upper limit motor temperature set to ensure continuous actuation of said motor or **when a temperature of the inverter** which drives said motor is not less than an upper limit inverter temperature set to ensure continuous actuation of said motor." (emphasis added)

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<sup>1</sup> This paragraph states "[t]he drive limit T<sub>lim</sub> is set, for example, as a value of 60% or 50% of a rated maximum torque of the motor MG2 at the revolution speed Nm2, when the motor temperature T<sub>m</sub> or the inverter temperature T<sub>inv</sub> is not lower than an upper limit motor temperature or an upper limit inverter temperature set as the upper threshold to ensure continuous actuation of the motor MG2."

Certain embodiments of the present invention provide a power output apparatus for a hybrid vehicle that accommodates heat generation in the motor or its driving circuit (e.g., an inverter), while keeping the power demand to be output from the internal combustion engine unchanged. The power output apparatus further comprises a drive restriction effectuation module that, when a predetermined restricting condition is fulfilled, effects a drive restriction of the motor based on the predetermined restricting condition. As disclosed in paragraphs [0037] and [0038] of the specification (US PG PUB 2006/0162972), temperature of the inverter is a factor in establishing the predetermined restricting condition. Thus, the embodiments of the independent claims 1, 5 and 15 all require that “wherein the predetermined restricting condition is fulfilled *when a temperature of said motor* is not less than an upper limit motor temperature set to ensure continuous actuation of said motor or *when a temperature of the inverter* which drives said motor is not less than an upper limit inverter temperature set to ensure continuous actuation of said motor.”

The Office Action argues that Abe discloses a predetermined restricting condition in S140 of Fig. 6. Abe discloses a power output unit and method for increasing the efficiency of a hybrid vehicle. (col. 5, ll. 17-22). As illustrated in S140 of Fig. 6, and the whole of the Abe disclosure, the only metric of the motor MG2 upon which the control unit bases its control is rotational speed of motor MG2. (Fig. 6; col. 9, ll. 7-8). The Office Action alleges Kuang supplements Abe and discloses a restriction of use of a motor in a hybrid vehicle based upon a temperature of the motor. However, Abe and Kuang, even in combination, do not teach or suggest a predetermined restricting condition “wherein the predetermined restricting condition is fulfilled *when a temperature of said motor* is not less than an upper limit motor temperature set to ensure continuous actuation of said motor or *when a temperature of the inverter* which drives said motor is not less than an upper limit inverter temperature set to ensure continuous actuation of said motor” as required by claims 1, 5 and 15. Further, the Applicant respectfully submits that Tadao does not address the critical deficiencies of Abe and Kuang.

As discussed in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching

\*>test< as a guard against using hindsight in an obviousness analysis). That said, the Office Action **does not** provide sufficient teaching, suggestion, or motivation in *the prior art itself* to modify the cited references, and appears to be using the invention as a blueprint to pick and choose unrelated features of unrelated references to reproduce, in hindsight, the invention.

Further, as discussed in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it is necessary to identify the reason why a person of ordinary skill in the art would have been prompted to modify the cited references in the manner as recited in the invention of claims 1, 5 and 15. Obviousness cannot be sustained by mere conclusory statements.

Therefore, for at least these reasons, it is respectfully submitted that claims 1, 5 and 15, and claims depending therefrom, are patentable over the cited references.

### **III. Conclusion**

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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